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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/993,696 12/18/97 SCHANZLIN

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EXAMINER

QM12/1117

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ART UNIT

PAPER NUMBER

3738

DATE MAILED:

11/17/00

18

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/993,696

Applicant(s)

SCHANZLIN et al.

Examiner

Dave Willse

Group Art Unit

3738



☒ Responsive to communication(s) filed on Aug 11, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-5, 11-13, 22-35, and 41-49 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-5, 11-13, 22-35, and 41-49 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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The Applicant's remarks in the Amendment of August 11, 2000, are deemed to be correct. The Office action of June 24, 1999, should have listed only four groupings or genera (as described by the Applicant) under the heading entitled "General Designs of Intracorneal Inserts". The examiner apologizes for the inconvenience to the Applicant.

The disclosure is objected to because of the following informalities: On page 11, line 25, the second occurrence of "a significant meridional length component (224) and" should be deleted. On page 14, line 17, "exceeds" should be --exceed--. The sentence on page 17, lines 25-26, lacks proper syntax. *Numerous other minor errors were noted, including a string of five or six grammar and spelling problems on page 29, lines 10-24.*

Claims 1-5, 11-13, 22-35, and 41-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 4, "its centroidal axis" lacks a proper antecedent basis. Claims 22-24 depend from a canceled claim. Claims 28 and 29 are believed to be vague and indefinite in that --elastic-- should be inserted after "low" or "high" on line 2 of each claim. *Other errors were noted.*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 5, 11, and 30-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Herrick, US 4,781,187. Regarding claim 32-33: column 1, lines 57-59; abstract.

Claims 3, 4, and 41-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrick, US 4,781,187. Regarding claims 3 and 4, the particular radius of curvature would have been immediately obvious from the intended use of the device, as best illustrated by Figures 3, 4, 7, and 9. Regarding claim 41, although Herrick specifies typical dimensions "on the order of a length of 3.5 to 4.0 millimeters" (column 3, lines 52-56), lengths of less than or equal to 2.5 millimeters would have been obvious in order to accommodate experimentation or practice on rabbits and other small animals or to minimize the length of the corneal incisions.

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Claims 1, 2, 5, 11, 30-35, and 41-46 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gonchar et al., "Interlayer Refraction Tunnel Keratoplasty in Correcting Myopia and Astigmatism". Regarding claim 41: page 4, line 16, of the English translation.

Claims 3, 4, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonchar et al. A radius of curvature within the range set forth in present claim 4 would have been immediately obvious from the purpose of the alloimplants (Figure 3). In regard to claim 49, an implant having a length of 2.0 mm or less would have been obvious in order to accommodate a variety of eye sizes and refractive disorders.

Claims 1, 2, 5, 11, 22, 23, 25, 26, and 30-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Civerchia, US 5,213,720. Regarding claim 1, the embodiments shown in Figures 14 and 17 can be inserted into the cornea (Figure 4; column 6, lines 20-21; column 18, lines 9-12) and thus possess a radius of curvature along a centroidal axis of at least 5.0 mm. Regarding claim 23: column 13, lines 28-35. Regarding claim 26: column 12, lines 9-13.

Claims 3, 4, 24, and 41-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Civerchia, US 5,213,720. Regarding claims 3 and 4, the particular radius of curvature would have been immediately obvious from the anatomy depicted in Figure 4. Regarding claim 24, an anti-inflammatory or an anti-thrombogenic would have been an obvious option relative to column 12, lines 9-13, because of the nature of the surgical procedure. Regarding claims 41 and 49, the length of the tabs 132 being less than or equal to 2.0 mm would have been obvious from the drawing (Figure 17) and would have been obvious in order to lessen the trauma to the cornea.

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Claims 1, 2, 5, 11, 12, and 27-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lindstrom, US 4,799,931.


Claims 3, 4, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindstrom, US 4,799,931. A value within the range set forth in claim 4 would have been obvious for reasons similar to those cited above. The particular material recited in claim 13 would have been obvious from the list of materials at column 2, lines 9-11.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DE 37 19 177 A1: advantageous material as a replacement for human donor corneas.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse  
November 17, 2000

  
**DAVE WILLSE**  
**PRIMARY EXAMINER**  
**ART UNIT 3738**